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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KARL JOHNSON, LOUIS MAGGIO, and
CLAYTON SEDERBERG

Appeal 2010-000613
Application 10/697,554
Technology Center 3700

Before LINDA E. HORNER, JOHN C. KERINS, and
STEVEN D.A. McCARTHY, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Karl Johnson et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1-22, 40-49, 51, 53, and 55-57 under 35 U.S.C. § 103(a) as unpatentable over Sederberg (US 5,992,023, issued November 30, 1999), Hrusch (US 5,894,666, issued

April 20, 1999), Aiken (US 402,381, issued April 30, 1889), Jacobson (US 6,839,969 B2, issued January 11, 2005), and Hall (US 5,187,868, issued February 23, 1993). Appellants provide rebuttal evidence in the form of a Declaration of Clayton Sederberg under 37 C.F.R. § 1.132 (“Decl.”) and accompanying Exhibits A-H. We have jurisdiction under 35 U.S.C. § 6(b).¹

We REVERSE.

THE INVENTION

Appellants’ invention relates to “an indexable wear plate/piercing tip insert that is configured to be removably and repositionably attached to the front, nose portion of the upper, movable jaw of a metal demolition shears.” Spec. 4, para. [0008]. Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An indexable wear plate/piercing tip insert configured to be attached at a front, nose portion of a correspondingly configured movable jaw of a metal demolition shears, the wear plate/piercing tip insert comprising:

a metal body having a central region and two ends, and

a metal tip portion disposed at each of said two ends, each said tip portion protruding laterally with respect to a surface of said central region in the direction of a first side of said body so as to define a piercing tip that extends at least partially across the width of the front, nose portion of the movable jaw when the wear plate/piercing tip insert is attached to the movable jaw;

wherein a second side of said body that is opposite to said first side has a generally planar surface to define a wear surface of said wear plate/piercing tip insert;

¹ An oral hearing was held on November 17, 2011.

wherein each said tip portion has a shearing edge on said second side of said body and a piercing edge disposed at an angle relative to and intersecting with said shearing edge, said piercing edge extending at least partially across the width of the front, nose portion of the movable jaw when the wear plate/piercing tip insert is attached to the movable jaw; and

wherein the geometric configuration of said wear plate/piercing tip insert is essentially the same in a first position and a second position, said second position being a position in which said wear plate/piercing tip insert is rotated about a pivot axis passing centrally through said wear plate/piercing tip insert, normal to said generally planar surface;

wherein a non-worn or less worn portion of said wear surface and non-worn or less worn shearing and piercing edges can be presented simultaneously for the metal demolition shear by rotating said wear plate/piercing tip insert about said pivot axis from said first position to said second position and reseating said wear plate/piercing tip insert on the movable jaw, and

wherein rotation of the wear plate/piercing tip insert between the first and second positions swaps the shearing edges of the two metal tip portions between operative and non-operative positions.

ISSUE

Appellants argue that it would not have been obvious to one of ordinary skill in the art to have applied the indexability of conventional blade insert members to the wear plate/piercing tip insert of Sederberg. App. Br. 26. Appellants argue that any reasonable combination of the prior art would not have resulted in the claimed invention as a whole. Reply Br. 2. *See also* App. Br. 29 (“one of ordinary skill in the art would have converted a piercing tip like the simple piercing tip 124 illustrated in FIG. 2

of [Sederberg] into an indexable piercing tip because the structure and support technique of the tip 124 is somewhat similar to the blade insert members 116 or the indexable blade inserts in Hrusch and Aiken.”). Appellants further argue that the Examiner’s failure to consider the evidence of secondary considerations of non-obviousness and the weight of the evidence of copying and commercial success compels reversal of the obviousness rejection. App. Br. 33-38; Reply Br. 7-9.

The issue presented by this appeal is:

Does the evidence in favor of obviousness outweigh the evidence of secondary considerations against obviousness?

ANALYSIS

Sederberg discloses one embodiment of demolition shears having a nose blade 124 welded onto the end of upper jaw 16 and a separate elongated wear plate 122 also welded to upper jaw 16. Col. 6, ll. 29-36; fig. 7. Sederberg discloses another embodiment of demolition shears having a nose member 140 comprised of an elongated wear plate portion 142 and an integrally formed nose piece 144 at its lower end, where the nose member 140 is secured to the upper jaw 16a by fasteners 146. Col. 6, ll. 56-61; fig. 10. Sederberg’s shears further include cutter blades 64, 66 disposed on lower jaw 14 and cutter blades 114, 116 disposed on upper jaw 16. Col. 5, ll. 15-17; col. 6, ll. 15-16; fig. 8. Sederberg discloses that the cutter blades are indexable, but it does not disclose an indexable nose blade or an indexable wear plate/nose blade insert. Col. 7, ll. 19-39; figs. 13, 14.

Hrusch discloses that extreme wear of jaw tips and the need for frequent replacement of such worn tips and the associated expense of such replacement were known problems in the art. Col. 1, ll. 53-59. Hrusch further discloses that it was known in the art to use indexable piercing and cutting tip blade inserts 62 and 64 on axially opposite sides of upper jaw 20. Col. 4, ll. 20-31; fig. 2. Hrusch shows a wear plate 58 that is separate from the piercing and cutting tip blade inserts 62 and 64. Col. 4, ll. 11-12; fig. 2.

Aiken discloses a shear-knife with an indexable cutting edge. Aiken 1, ll. 65-71. Neither Hall nor Jacobson discloses indexable piercing tips or indexable wear plate/piercing tip inserts. *See* Hall, col. 4, ll. 9-11; fig. 5, (showing replaceable, but not indexable, cutter tip 14) and Jacobson, col. 3, ll. 19-21; fig. 2 (showing replaceable, but not indexable, shearing tip 110).

While the prior art discloses that it was known in the art to use indexable blades and piercing tips in demolition shears, the only indexable piercing tips shown in the art are of simple construction (tips only) and are not combined in an integral fashion with a wear plate. As such, the prior art tends to show that one having ordinary skill in the art seeking to make the piercing tip of Sederberg indexable might have been led, in view of Hrusch and Aiken, to make the separate nose blade 124 of Sederberg's first embodiment (shown in Figure 7) indexable, rather than attempting to fashion an indexable piercing tip out of Sederberg's integral wear plate/nose piece 140 (shown in Figure 10).

Further, Appellants' evidence of secondary considerations tends to show that the claimed indexable wear plate/piercing tip insert would not

have been obvious to one of ordinary skill in the art. The Sederberg Declaration shows that two competitors of Stanley LaBounty copied the claimed insert after Stanley's insert had entered the market. The evidence shows that Stanley first incorporated the claimed indexable wear plate/piercing tip insert into its shears in 2003. Decl. para. 6. The evidence shows that in 2006 Genesis, a Stanley competitor, was selling replacement inserts for Stanley's shears that were an exact copy of the claimed indexable wear plate/piercing tip insert. Decl. para. 9, and Exhibits A-C. When confronted by Stanley, Genesis agreed to stop making and selling the replacement insert. Decl. para. 10 and Exhibit D. This evidence of copying by Genesis tends to show that by 2006, Stanley had garnered enough of a market share to create a lucrative aftermarket for replacement inserts.²

The evidence also shows that in 2005, Trevi Benne, another Stanley competitor, began selling competing shears with an indexable wear plate/piercing tip insert that looked strikingly similar to Appellants' commercial shears embodying the claimed invention. Decl. para. 12 and Exhibits F & G. *See Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985) ("Access in combination with similarity can create a strong inference of copying"). When confronted by Stanley, Trevi Benne agreed to stop making and selling the shears containing the claimed indexable wear plate/piercing tip insert. Decl. para. 13 and Exhibit H.

² By 2008, "In the North American Market, Stanley ha[d] approximately 50% market share of the Excavator Mobile Shears." Decl. para. 7.

Generally “more than the mere fact of copying . . . is needed to make that action significant to a determination of the obviousness issue” because the alleged copying could have occurred out of a general lack of concern for patent property. *See Cable Elec.*, 770 F.2d at 1028. In this case, however, we have before us evidence of copying and evidence that the competitor ceased making and selling the copied inserts once confronted with Stanley’s patent property. While we acknowledge that we have no evidence that Trevi Benne attempted for a substantial length of time to design a similar device and failed, and we have no internal documents from Trevi Benne showing an intentional replication of Stanley’s product, we recognize that such evidence is often difficult to obtain from a competitor outside of the litigation context. We find that the striking similarity of Trevi Benne’s wear plate/piercing tip insert to Appellants’ product combined with Trevi Benne’s agreement to stop making and selling shears incorporating the wear plate/piercing tip insert is evidence of copying that tends to weigh in favor of the non-obviousness of the claimed invention.

On balance, the relatively weak evidence in support of the Examiner’s obviousness determination when considered against Appellants’ apposite evidence of secondary considerations does not weigh in favor of a conclusion of obviousness. For these reasons, we will not sustain the rejection of claims 1-22, 40-49, 51, 53, and 55-57 under 35 U.S.C. § 103(a).

CONCLUSION

The evidence in favor of obviousness does not outweigh the evidence of secondary considerations against obviousness.

Appeal 2010-000613
Application 10/697,554

DECISION

The decision of the Examiner to reject claims 1-22, 40-49, 51, 53, and 55-57 is REVERSED.

REVERSED

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